

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Steven M. RUBEN

Appl. No.: 10/662,429

Filed: September 16, 2003

For: **Apoptosis Inducing Molecule I**

Confirmation No.: 2663

Art Unit: 1644

Examiner: HUYNH, PHUONG N.

Atty. Docket: 1488.1890003/EJH/SAC

**Declaration of Kathryn L. Beckman
Ruben Exhibit #33**

Ruben EXHIBIT #33

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Filed on Behalf of Party Ruben

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
(Administrative Patent Judge Sally Gardner Lane)

STEVEN M. RUBEN

Junior Party,
(Application 08/816,981),

v.

STEVEN R. WILEY and RAYMOND G. GOODWIN

Senior Party,
(Patent No. 5,763,223).

Patent Interference No. 105,077

DECLARATION OF KATHRYN L. BECKMAN

Ruben EXHIBIT 2033
Ruben v. Wiley et al.
Interference No. 105,077.
RX 2033

DECLARATION OF KATHRYN L. BECKMAN

I, Kathryn L. Beckman, hereby declare and state as follows:

1. From February 1995 until June 1998, I was employed by Human Genome Sciences, Inc. (HGS) in the position of Intellectual Property Administrator in the HGS Legal Department. I reported directly to Dr. Robert Benson, who was the head of the Legal Department. My duties as Intellectual Property Administrator included establishing and supervising the operation of HGS's patent docket system, as well as corresponding with outside counsel and HGS scientists regarding the preparation of patent applications. During the 1995 to 1996 time frame, the outside counsel responsible for the vast majority of HGS patent application preparation was the law firm Carella, Byrne, Bain, Gilfillan, Cecchi, Stewart & Olstein ("Carella") of Roseland, New Jersey.

2. On January 31, 1996, I sent a letter to Gregory D. Ferraro, an attorney at Carella, forwarding a completed invention disclosure form (also referred to as a questionnaire) and references for preparing a new patent application, which was assigned the HGS reference number PF261 (the "PF261 application"). RE341. The PF261 application was at that time named "Fas Ligand." RE341. The filing of this particular patent application was a top priority to HGS. Accordingly, in that January 31, 1996 letter, I instructed Mr. Ferraro to "give the PF261 application priority over all other applications you are currently handling for HGS in order that it may be drafted and filed on an expedited basis." RE341.

3. The extreme urgency accorded the PF261 application is reflected in an e-mail dated January 31, 1996 from Robert Benson to Steven Ruben, on which I was

copied. RE35. Initially, Dr. Benson expressed the hope that the application could "be ready in a few days." RE35.

4. The extreme urgency of the PF261 application is also reflected in the New Patent Disclosure Checklist that I prepared for this application. RE36. The checklist contains my handwritten notation indicating that the PF261 application was to be handled on a "Rush!" basis. RE36 i. Furthermore, initially, the due date for the final draft from Carella was indicated to be February 14, 1996, which was an extremely short time frame for the preparation of a patent application on behalf of HGS.

5. On Friday, February 2, 1996, Mr. Ferraro sent a copy of the draft application to Robert Benson of HGS, under a cover letter asking Dr. Benson to have the application reviewed (RE37). The letter, which was received by the HGS Legal Department on Monday, February 5, 1996, contains my handwritten notation indicating the initial final draft due date of February 14, 1996. RE37.

6. As Intellectual Property Administrator of HGS, I instituted, supervised and in some instances directly operated a standard docketing procedure that was in use in 1996 for marking a series of actions to be taken from the sending of a patent questionnaire to Carella (*i.e.*, "CB") to the filing of the patent application by Carella. RE38. The amount of time allotted for this process spanned a period of time of at least ten weeks. RE38 items 1-6. After the initial indication of a February 14, 1996 due date for a final draft (an extreme rush basis for preparing a patent application), this standard docketing procedure was applied to the preparation of the PF261 application. RE38. While the initial, extremely expedited due date for the final draft of February 14, 1996 appears to have been modified, the preparation of the PF261 application was

carried out in a manner that was nonetheless much more expeditious than usual. In particular, in the case of the PF261 application, the entire process docketed according to HGS's usual procedure spanned the time frame from January 31, 1996 (the date the patent questionnaire was sent by HGS to Carella, RX 2034) to March 14, 1996 (the date the application was filed in the U.S. Patent and Trademark Office, RE38). Thus, the overall time span from the beginning to the end of this application preparation process was approximately only six weeks. This six week period is much shorter than the at least ten week period provided for under this standard HGS docketing procedure. Moreover, six weeks was much shorter than the typical time span in which Carella prepared applications on behalf of HGS, in practice, during the 1995 to 1996 time frame.

7. Moreover, each of the individual steps taken by both Carella and HGS were within the standard time period allotted, and in most cases much shorter than the allotted time periods for each step. I sent the questionnaire to Carella on January 31, 1996, requesting at the outset that the application be given "priority over all other applications" that Carella was working on for HGS. RE341. This action corresponds to step 1 in the docketing procedure. RE38. The next item and date to be docketed according to this procedure is to receive a draft application from Carella within two weeks, so that the draft application could be forwarded to the inventor within this two week period. RE38. The application was received on February 5, 1996 and forwarded to the inventor on February 14, 1996. RE38. Thus, the draft application was both received and forwarded to the inventors within the docketed two week time frame. RE38. The next item and date to be docketed according to this procedure (step 2) is for the HGS Legal Department to receive a reviewed draft back from the

inventor within two weeks of the date it was sent to the inventor. RE38. The two week date of Wednesday, February 28, 1996 for receipt of the inventor-reviewed draft was, in fact, docketed. RE38, wherein the circled "D" denotes "docketed." The purpose of this step was for the Legal Department to obtain adequate feedback on the draft application from the inventor in order to instruct the outside counsel to continue its preparation of the application. On information and belief, including the Carella billing record for Carella docket number 325800.549 (RE39, I conclude that the sufficient feedback was received by the HGS Legal Department on or around the docketed date of Wednesday, February 28, 1996; and pursuant to the instructions of HGS's Legal Department, Carella then began carrying out the further preparation of the application on Monday, March 4, 1996. Finally, the application was further prepared, completed, and filed by Carella about two weeks after the February 28, 1996 docket date (on March 14, 1996), which is much less than the at least five weeks allotted by HGS's usual docketing system for completing these tasks. RE38, items 3-8.

8. Based on the foregoing, I conclude that from the time HGS contacted Carella on January 31, 1996 (RE34, until the filing of the application for HGS docket number PF261 on March 14, 1996 (RE38), the application preparation process was carried out with greater than normal diligence accorded HGS applications in the usual course of HGS's practice.

9. From at least the beginning of 1996 and throughout my employment at HGS, HGS had a standard practice for making microorganism and plasmid deposits with the ATCC®. First, a standard Purchase Order form was filled out by the individual in the HGS Legal Department in charge of generating and maintaining the standard deposit

records. In addition, an ATCC® form BP/1 was filled out by this same individual, providing the ATCC® with the information it required about the microorganism or plasmid. Typically, an Appendix was added to the BP/1 form to describe the technical qualities of the deposited microorganism or plasmid and details for producing it from the deposited sample. This BP/1 form with any attached appendices was then approved by the head attorney of the HGS Legal Department. The deposit was then sent to the ATCC® with the BP/1 form. Within one to two weeks, the ATCC® sent HGS a Deposit Receipt, which was date-stamped and then placed into the file of the relevant patent application, as well as a centralized file in the HGS Legal Department of all such microorganism deposits.

10. In February 1996, the standard HGS Legal Department procedure for depositing microorganisms with the ATCC® described above was used for the deposit of a plasmid in connection with HGS docket number PF261. I have reviewed at least certain of the records of the deposit for HGS docket number PF261. On Friday, February 16, 1996, a Purchase Order to make a deposit with the ATCC® was filled out by Tina Powers, who was an Administrative Assistant in the HGS Legal Department in charge of maintaining the deposit records at that time; and the Purchase Order was approved on February 16, 1996 by Dr. Benson, as shown on the standard HGS Purchase Order Form for purchase order 25023. RE40. Also on February 16, 1996, an ATCC® form BP/1 was filled out for docket number PF261 to deposit a plasmid designated 413412 and approved by Dr. Benson. RE41. On Tuesday, February 20, 1996, the day after the Monday, February 19, 1996 President's Day holiday, the deposit was received by the ATCC®, as indicated on the ATCC® deposit receipt for plasmid 413412. RE42. On

February 23, 1996, the ATCC® tested the viability of the culture and on that date, the culture was viable, as indicated on the ATCC® deposit receipt for plasmid 413412.

RE42 . On February 27, 1996, the ATCC® deposit receipt was received by the HGS Legal Department and date-stamped. RE42 .

11. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under § 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application captioned above or any patent issuing thereupon.

Date: June 21, 2004

Kathryn Beckman
Kathryn L. Beckman

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